

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: September 12, 2023

Mailed: November 9, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Montgomery Law LLC

v.

Jacobson & John LLP
—

Cancellation No. 92073600
—

Alex Kerr of Alex Kerr Law LLC,
for Montgomery Law LLC.

Craig S. Hillard of Stark & Stark, P.C.,
for Jacobson & John LLP.
—

Before Lykos, Lynch and Cohen,
Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

Respondent, Jacobson & John LLP, is the owner of a registration on the Principal Register, with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, for the mark THE EDUCATION LAWYERS, with LAWYERS disclaimed, for “legal services” in International Class 45.¹ Respondent’s claim of acquired

¹ Registration No. 5545212, was issued on August 21, 2018 from an application filed January 17, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 1, 2010, as the date of first use anywhere and date of first use in commerce.

distinctiveness is based solely on a declaration of at least five years of continuous and substantially exclusive use prior to making the statement.

Petitioner, Montgomery Law LLC, seeks cancellation of Respondent's registration on the ground that the mark is generic of the identified services, or in the alternative, highly descriptive and has not acquired distinctiveness.²

In its answer, Respondent:

- admits that "Petitioner uses the words 'education lawyer' on its' [sic] website";³
- admits that Respondent "describes its' [sic] partners as 'education lawyers' as well as 'special education lawyers' within its website and that Petitioner's website uses 'education lawyers' within its site";⁴
- admits that Respondent "contacted Petitioner's law firm";⁵
- admits that Respondent "sent a cease-and-desist letter to Petitioner";⁶ and
- admits that its mark "is descriptive" but denies that it is "highly descriptive."⁷

Respondent denies the remaining salient allegations in the petition to cancel and enumerates four purported affirmative defenses.⁸

² 1 TTABVUE. When we cite to the record, we refer to TTABVUE, the Board's docketing system, by docket entry and page number (e.g., 38 TTABVUE 14).

³ 5 TTABVUE 2 at ¶ 2.

⁴ 6 TTABVUE 3 at ¶ 5.

⁵ *Id.* at 3 at ¶ 11.

⁶ *Id.* at ¶ 12.

⁷ *Id.* at 4 at ¶18.

⁸ 6 TTABVUE; *see* 86 TTABVUE 53. A legally sufficient pleading of an affirmative defense must include enough factual detail to provide Petitioner fair notice of the basis for the defense. Fed. R. Civ. P. 8(b)(1) and 12(f); *see e.g., IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, 5

The case is fully briefed,⁹ and the parties appeared before the Board for an oral hearing on September 12, 2023.¹⁰

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's involved registration.¹¹

Petitioner included various exhibits with its petition to cancel. While a plaintiff may attach exhibits to its pleading, except for current status and title copies of a plaintiff's pleaded registration, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *see Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004) (exhibits to pleading

USPQ2d 1067, 1069 (TTAB 1980). The affirmative defenses are non-specific or merely conclusory in nature, and therefore are insufficiently pleaded or as to its failure to state a claim defense, not a true defense. *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) (citing *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001)). Further, Respondent did not pursue its affirmative defenses at trial and thus, they are deemed waived. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *2 (TTAB 2020) (party "did not present any evidence or argument with respect to these asserted defenses at trial, so they are deemed waived"); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) ("As applicant did not pursue the affirmative defenses of failure to state a claim and unclean hands, either in its brief or by motion, those defenses are waived."); *TPI Holdings, Inc. v. TrailerTrader.com LLC*, 126 USPQ2d 1409, 1413 n.28 (TTAB 2018) ("Respondent also asserted 'estoppel, acquiescence and waiver,' but does not argue any of these in its brief. They are therefore waived."). Accordingly, we give no further consideration to the affirmative defenses.

⁹ Petitioner's briefs are at 40 and 44 TTABVUE. Respondent's brief is at 42 TTABVUE.

¹⁰ 49 TTABVUE.

¹¹ For this reason, it was unnecessary for Petitioner to submit the file of Respondent's Registration under Notice of Reliance. 18 TTABVUE.

not evidence of record); *Hard Rock Café Int'l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (brief may not be used as a vehicle for introduction of evidence); *Home Juice Co. v. Runmlin Cos.*, 231 USPQ 897, 898 (TTAB 1986) (exhibits attached to the parties' pleadings are not in evidence and given no consideration). The exhibits attached to Petitioner's petition to cancel are therefore given no consideration.

Petitioner argues that "Merriam-Webster defines 'education' as 'the action or process or educating or of being educated.' It defines 'lawyer' as 'one whose profession is to conduct lawsuits for clients or to advise as to legal rights and obligations in other matters.'"¹² Petitioner references these definitions but gives no indication whether the dictionary entries were retrieved online or from a printed format, has not properly made them of record during its trial period, and does not request we take judicial notice. Accordingly, we do not consider these definitions. *See, e.g., In re Total Quality Grp. Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999).

Petitioner submitted¹³ a Notice of Reliance consisting of copies of Respondent's Registration and the X-Search summary,¹⁴ the testimony declaration of Joseph Montgomery, founding partner and owner of Petitioner with exhibits, and the testimony declarations of A. Lynn Himes, Eric Ransleben, Kate Gerland and Neal

¹² 40 TTABVUE 15.

¹³ Only Petitioner submitted evidence during its assigned trial period. However, only Petitioner was required to file a brief, Trademark Rule 2.128(a)(1), 37 C.F.R. § 2.128(a), and to submit evidence. Petitioner bears the burden of proving that Respondent is not entitled to a registration "even in the absence of contrary evidence or argument." *DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249, at *21 (TTAB 2022) (citing *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010)); *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1531 n.13 (TTAB 2018).

¹⁴ 18 TTABVUE.

Rosenberg.¹⁵ The Board, in a partial grant of Respondent's motion to strike, struck the Montgomery testimony declaration and exhibits 1 and 8, and the Himes, Ransleben, Gerland and Rosenberg testimony declarations for being signed and executed outside of Petitioner's testimony period.¹⁶

The following evidence remains of record:

- Notice of Reliance on TSDR records from Respondent's Registration file consisting of a copy of the TEAS application along with the Examining Attorney's X-Search search summary;¹⁷ and
- Exhibits 2-7 comprised of Internet printouts appended to the Joseph Montgomery testimony.¹⁸

II. Entitlement to a Statutory Cause of Action

Respondent does not dispute Petitioner's entitlement. Notwithstanding, a petitioner's entitlement to a statutory cause of action for cancellation of a registration is a necessary element in every cancellation proceeding. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671, 210 L.Ed.2d 833 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82, 211 L.Ed.2d 16 (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). Petitioner may seek to cancel Respondent's registration if Petitioner's interests fall within the zone

¹⁵ 20-23 TTABVUE.

¹⁶ 30 TTABVUE 6-7.

¹⁷ 18 TTABVUE. Because the entire file of the challenged registration is automatically of record, Petitioner need not have submitted these materials.

¹⁸ 19 TTABVUE.

of interests protected by the statute, 15 U.S.C. § 1064, and Petitioner has a reasonable belief in damage that is proximately caused by the continued registration of Respondent's mark. *Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *1 (TTAB 2020).

A "zone of interest" encompasses any legitimate commercial interest in the use of the registered marks. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (a plaintiff must have a "legitimate commercial interest sufficient to confer standing."). When challenging a term as generic or descriptive, "a plaintiff need only show that it is engaged in the ... sale of the same or related [services] as those listed in the defendant's involved application or registration and that the [service] in question is one which could be [provided] in the normal expansion of plaintiff's business; that is, that plaintiff has a real interest in the proceeding because it is one who has a present or prospective right to use the term descriptively in its business." *Poly-Am., L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (quoting *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1010 (TTAB 1984)); *see Kellogg Co. v. Gen Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007); *Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 23 USPQ2d 1878, 1879 (TTAB 1992), *aff'd*, 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993); *Int'l Dairy Foods Assn.*, 2020 USPQ2d 10892, at *10. A petitioner "is required only to be in a position to have a right to use the mark in question." *Poly-Am.* 124 USPQ2d at 1512 (citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1028 (Fed. Cir. 1999)).

Reading the entirety of the pleadings, and specifically, Respondent’s admissions in its Answer that “Petitioner’s website uses ‘education lawyers’ within its site”;¹⁹ and that Respondent “sent a cease-and-desist letter to Petitioner”;²⁰ we find that Petitioner has a legitimate interest in this proceeding. *See Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017), *rev’d on other grounds by stipulation pursuant to settlement agreement*, No. 3:17-cv-02150-AJBMSB (S.D. Cal. Apr. 13, 2021); *Miller v. Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988). Respondent implicitly acknowledges these admissions in its Brief. As Respondent states in its Brief, “[a]fter receiving a cease-and-desist letter from Registrant attributable to Petitioner’s infringing use of the Mark, [Petitioner] brought this cancellation proceeding to stop what it perceived to be the monopolization of the allegedly generic and descriptive words ‘education lawyers.’”²¹ As such, Petitioner is entitled to bring the causes of action herein.

III. Analysis of Petitioner’s Claims

“Because a trademark owner’s certificate of registration is ‘prima facie evidence of the validity of the registration’ and continued use of the registered mark, the burden of proof is placed upon those who seek cancellation. 15 U.S.C. § 1057(b) ... the petitioner’s burden is to establish the case for cancellation by a preponderance of the

¹⁹ 6 TTABVUE 3 at ¶ 5; *see also* 5 TTABVUE 2 at ¶ 2.

²⁰ 6 TTABVUE 3 at ¶ 12.

²¹ 42 TTABVUE 7.

evidence.” *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). In a cancellation proceeding, the petitioner has the burden of proving descriptiveness or genericness by a “preponderance of the evidence.” *Real Foods Pty Ltd. Frito-Lay N. Am. Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006).

A. Descriptiveness and Acquired Distinctiveness

Respondent’s Registration is registered under Trademark Act Section 2(f),²² 15 U.S.C. § 1052(f), which operates as a concession of the descriptiveness of THE EDUCATION LAWYERS for the identified services. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009); *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1527, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1679-80 (TTAB 2007); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1479 (TTAB 2016); However, we discuss the degree of descriptiveness below, as part of analyzing the claim of lack of acquired distinctiveness.

²² Trademark Act Section 2(f) permits the registration of a mark that would otherwise be refused under Section 2(e)(1) if the mark “has become distinctive of the applicant’s goods [or services] in commerce.” “To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.” *Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 USPQ2d 714, at *20 (TTAB 2022) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)); *see also Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012).

The party seeking cancellation in a Section 2(f) case bears the initial burden to “establish a prima facie case of no acquired distinctiveness.” *Cold War Museum*, 92 USPQ2d at 1630 (quoting *Yamaha Int’l Corp.*, 6 USPQ2d at 1576). To satisfy this initial burden, Petitioner must “present sufficient evidence or argument on which the board could reasonably conclude” that the party has overcome the record evidence of acquired distinctiveness – which includes everything submitted by Respondent during prosecution. *Id.* (citing *Yamaha Int’l Corp.*, 6 USPQ2d at 1576-77). If this initial burden is met, the burden shifts to Respondent to produce evidence or argument in defense of registration. *Id.* But “[t]he party seeking to cancel registration of a mark always bears the burden of persuasion, that is, the ultimate burden of proving invalidity of the registration by a preponderance of the evidence.” *Id.* at 1629.

“A petitioner *may* carry its initial burden of showing prima facie invalidity by introducing evidence at trial that the mark is so highly descriptive that a mere declaration of five years continuous and substantially exclusive use is insufficient to establish acquired distinctiveness, so that actual evidence of acquired distinctiveness in the form of sales and advertising information and the like is necessary” (emphasis in original). *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1765 (TTAB 2013), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); see *Flame & Wax*, 2022 USPQ2d 714, at *20 (TTAB 2022) (quoting *Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1211 (TTAB 2018)). Accordingly, we must first determine the degree of descriptiveness. See *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018) (“If it reaches the question of acquired

distinctiveness, the Board must make an express finding regarding the degree of the mark's descriptiveness on the scale ranging from generic to merely descriptive, and it must explain how its assessment of the evidentiary record reflects that finding.”).

“Evidence of the public’s understanding of [a] term ... may be obtained from any competent source, such as purchaser testimony, consumer surveys, listing in dictionaries, trade journals, newspapers and other publications,” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *Royal Crown Co.*, 127 USPQ2d at 1046), as well as “advertising material directed to the [services]” *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). It may also be obtained from websites and, in the case of a use-based application or registration, an applicant’s or registrant’s own specimen of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

i) Analysis of Evidence

Petitioner has not submitted any direct evidence of consumer perception in the form of consumer testimony or a consumer survey. The only evidence of record, as noted, consists of materials from the file of Respondent’s Registration,²³ and printouts from the Internet with no accompanying testimony.

²³ The screenshot from the May 2, 2018 X-Search, included in Petitioner’s Notice of Reliance, is insufficient to make any registrations of record. May 2, 2018 X-Search Summary at TSDR 1.

As to Petitioner's Notice of Reliance, as noted, without testimony, the specimens included in the file of Respondent's Registration are not evidence of use by Respondent. The screenshot of the May 2, 2018 search summary of the USPTO's X-Search database is of little probative value.²⁴ The summary indicates the search was conducted by the Examining Attorney but does not specify the marks involved in the applications or registrations found, the goods or services associated with each application or registration, or any information about who owns the applications or registrations (e.g., a third party) and Petitioner has not otherwise made these or any third party applications or registrations of record.

The Internet printouts consist of: search results from the website legalmatch.com for the terms "education lawyers";²⁵ pages from web.archive.org displaying Petitioner's 2018 website, educationlawyers.com;²⁶ a page from web.archive.org displaying the 2001 website educationlawyers.com from the law firm Stroup & de Goede;²⁷ a page from web.archive.org displaying the 2017 website of asseltalaw.com from Asselta Law P.A.;²⁸ pages from Petitioner's 2021 website educationlawyers.com;²⁹ and pages from Respondent's 2021 website,

²⁴ The X-Search summary is insufficient to make any registrations of record. May 2, 2018 X-Search Summary at TSDR 1.

²⁵ 19 TTABVUE 11-15, exhibit 2.

²⁶ *Id.* at 16-34, exhibit 3.

²⁷ *Id.* at 36, exhibit 4.

²⁸ *Id.* at 48, exhibit 6.

²⁹ *Id.* at 37-46, exhibit 5.

theeducationlawyers.com.³⁰ As explained below, the probative value of these printouts is also limited.

Because there is no testimony from a witness based on personal knowledge linking these Internet printouts to any of the parties or explaining the information found therein, these Internet printouts cannot be used to demonstrate the truth of the matter asserted because they constitute hearsay. Fed. R. Civ. P. 802; *see, e.g., Empresa*, 2022 USPQ2d at *7 (where “the parties seek to rely on the contents of the Internet printouts for the truth of any assertion made therein, the statements in the websites are hearsay unless supported by testimony or other evidence”), *civil action filed*, No. 1:23-cv-00227 (E.D. Va. Feb. 20, 2023); *Spiritline Cruises LLC v. Tour Mgmt. Serv., Inc.*, 2020 USPQ2d 48324, at *2 (TTAB 2020) (Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony considered only for what they show on their face rather than for the truth of the matters asserted). As such, Internet printouts are admissible to show not the truth of their content but rather that the public has been exposed to them and to show the meaning of the mark. *See, e.g., Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731 (TTAB 2012) (Internet printouts acceptable to show only that statements were made or the information was reported in the webpages); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011); *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (because website content is accessible by the consuming public, it constitutes evidence that the public may be

³⁰ *Id.* at 49-51, exhibit 7.

exposed to statements appearing therein); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1798 (TTAB 2001) (Internet materials are not evidence of use but may have some probative value to show the meaning of a mark).

ii) Petitioner's and Third-Party Uses

For the reasons explained above, we consider the third-party Internet evidence only as reflecting consumer exposure to what the webpages show on their face. The legalmatch.com printouts contain references to “education law” and “education lawyers” including (emphasis added):

- “**Education law** encompasses the right to a free and appropriate public education ...”;³¹
- “**Education law** encompasses issues in the education system pertaining to students, parents, teachers ...”;³² and
- “Should I Consult an **Education Lawyer**?”

A government attorney experienced in the area of education and schools can help parents ...”³³

Petitioner also includes an archived 2017 webpage from Asselta Law which reads “*The Education Lawyers*” (emphasis in original).³⁴

Petitioner asserts that it obtained its website, educationlawyers.com from a prior owner, providing a copy of an archived webpage from 2001 which reads: “The law firm Stroup & de Goede ... As specialists in education law, we are uniquely

³¹ *Id.* at 11, exhibit 2.

³² *Id.* at 12, exhibit 2.

³³ *Id.*

³⁴ *Id.* at 48.

equipped and qualified to provide legal advice and representation on all issues involving educational institutions and their governing boards.”³⁵

Petitioner also references its 2018 website, examples of which are:

- “**Education Lawyers** with a focus on excellence”;³⁶



- ³⁷

- “ADVISORS ()

We are available to advise and guide you through the intricacies of **education law** from behind the scenes”;³⁸ and

- “*Montgomery Law, We are Education Law*” (emphasis in original);³⁹

and its 2021 website, examples of which are:

- “**Education Lawyers** that advocate exclusively for Parents and Students ...”;⁴⁰ and
- “You might know our **Education Lawyers** from ...”⁴¹

³⁵ *Id.* at 36, exhibit 4; *see also* 40 TTABVUE 8.

³⁶ *Id.* at 17, exhibit 3.

³⁷ *Id.* at 17 and 34, exhibit 3.

³⁸ *Id.* at 20, exhibit 3.

³⁹ *Id.*

⁴⁰ *Id.* at 39, exhibit 5.

⁴¹ *Id.* at 43, exhibit 5.

Additionally, as to the archived webpage from Asselta Law, the screenshot bears a 2017 date.⁴² As to the Stroup & de Goede webpage, we note the archived webpage does not use THE EDUCATION LAWYERS but does use “education law.”⁴³

Although this evidence supports at least some public exposure to use of “education law” and “education lawyers” to refer to a type of lawyer or area of legal practice, the quantity of evidence is small. As to the few examples in the record, without testimony or evidence indicating how many views these websites have received⁴⁴ or if the scope of consumer exposure to them was nationwide, regional, or otherwise restricted, or how long the websites were available to the public, their probative value is quite limited.

⁴² Respondent argues that Asselta Law no longer displays THE EDUCATION LAWYERS on its current website, providing a hyperlink in Respondent’s brief. 42 TTABVUE 13, 20. However, providing hyperlinks to Internet materials is insufficient to make such materials of record. See *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (stating that “a reference to a website’s internet address is not sufficient to make the content of that website or any pages from that website of record”); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (noting that because of the transitory nature of Internet postings, websites referenced only by links may later be modified or deleted). Additionally, as it has been provided outside of Respondent’s trial period, it is untimely. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008) (“The Board sets trial periods during which the parties may submit evidence by filing notices of reliance or by taking testimony. Evidence submitted outside of the trial periods ... is untimely, and will not be considered.”).

Thus, we have not considered the information contained in the hyperlink.

⁴³ 19 TTABVUE 36.

⁴⁴ Petitioner argues that the legalmatch.com website reads that “it has helped more than ‘5 million clients find the right lawyer.” 44 TTABVUE 7; 19 TTABVUE 14. However, as discussed, inasmuch as this evidence was not accompanied by testimony, the statement on the webpage cannot be relied on for the truth of how many clients were helped by legalmatch.com.

Despite Petitioner’s argument that “[n]umerous firms have used the term ‘education lawyer(s),”⁴⁵ the only current uses of record are Petitioner’s website and the legal directory legalmatch.com. Even if we include the archived Asselta Law website, the evidence of record remains minimal (with just three uses, including Petitioner’s use). Given the nature and amount of evidence, it is not enough to demonstrate that use of “education lawyers” is highly descriptive for legal services. *Cf. Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *7 (TTAB 2020) (“The nature and number of third-party descriptive uses in the record undermines Applicant’s attempt to obtain trademark rights in a designation that is not inherently distinctive, because it interferes with the relevant public’s perception of the designation as an indicator of a single source”); *Ayoub, Inc. v. ACS Ayoud Carpet Serv.*, 118 USPQ2d 1392 (TTAB 2016) (finding no

⁴⁵ 40 TTABVUE 16. “Factual statements made in a party’s brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial.” TBMP § 704.06(b); *see also Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (affirming Board’s exclusion of assertions of fact made in a brief and agreeing with the Board that they are not evidence introduced at trial); *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”); *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in brief carry no weight unless supported by evidence introduced at trial or except as admission against interest).

acquired distinctiveness “as a result of the cumulative effect of Opposers’ and various third-party uses” of applicant’s alleged mark).

In sum, this record hardly evidences widespread use of THE EDUCATION LAWYERS in the legal field.

iii) Respondent’s Use

Petitioner asserts that Respondent’s website, theeducationlawyers.com, uses THE EDUCATION LAWYERS descriptively, if not generically, providing copies of the website, theeducationlawyers.com, including (emphasis added):



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- “**The Education Lawyers** are pleased to announce that we have resumed in-person intakes for our prospective clients”;⁴⁷
- With nearly 45 years of collective experience in **education law**, our **education attorneys** have developed extensive knowledge and skills ... attempting to obtain the educational services that they need and deserve for their children”;⁴⁸ and
- an embedded weblink “**Contact The Education Lawyers** today to schedule a free one-hour consultation.”

These webpages reflect descriptive use of “education law” and “education attorneys.” Because Respondent’s display of THE EDUCATION LAWYERS in some instances is followed by the ® symbol or with initial capital letters, the public may

⁴⁶ 19 TTABVUE at 50, exhibit 7.

⁴⁷ *Id.*

⁴⁸ *Id.*

also perceive Respondent's use as trade name use. *See In re Country Music*, 100 USPQ2d 1824, 1829 (TTAB 2011). (use of initial capitalization may be indicative of trade or brand name use). As noted, Respondent admits that its mark is descriptive, although it denies that its mark is highly descriptive of the identified services, and maintains that the mark has acquired distinctiveness.⁴⁹ *See, e.g., Abcor Development Corp.*, 200 USPQ at 218 ("Evidence of the context in which a mark is used ... in advertising material ... is probative of the reaction of prospective purchasers to the mark"); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2019) ("Evidence that a term is merely descriptive similarly may come from an applicant's [or registrant's] own usage other than that found on its labels, packaging or advertising materials.").

Considering all the evidence, and bearing in mind the presumed validity of Respondent's registered mark, the limited record in this case that "education lawyers" has been used descriptively does not support the conclusion that the mark is highly descriptive. Nor does it support a finding that Respondent's use has not been "substantially exclusive." Petitioner has not met its burden to "establish a prima facie case of no acquired distinctiveness." *Cold War Museum*, 92 USPQ2d at 1630 (quoting *Yamaha Int'l Corp.*, 6 USPQ2d at 1576).

B. Genericness

A generic term is "the name of a class of products or services" and "is ineligible for federal trademark registration." *U.S. Patent & Trademark Office v. Booking.com B.V.*, 140 S.Ct. 2298, 2020 USPQ2d 10729, at *2-3 (2020); *Park 'N Fly, Inc. v. Dollar*

⁴⁹ 6 TTABVUE 4 at ¶ 18.

Park & Fly, Inc., 469 U.S. 189, 224 USPQ 327, 329 (1985) (“Generic terms are not registrable[.]”); *In re Uman Diagnostics AB*, 2023 USPQ2d 191, at *3 (TTAB 2023) (generic name of a thing is “ultimate in descriptiveness” and “is not entitled to registration on either the Principal or Supplemental Register under any circumstances.”). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term to be protected to refer to the genus of goods or services in question.” *In re GJ & AM*, 2021 USPQ2d 617, at *4 (TTAB 2021) (quoting *Royal Crown*, 127 USPQ2d at 1045 (quoting *Marvin Ginn. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986))); *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009) (“The test is not only whether the relevant public would itself use the term to describe the genus, but also whether the relevant public would understand the term to be generic.”).

“Whether a particular term is generic is a question of fact.” *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *6 (TTAB 2021) (citing *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009)); *see also Booking.com*, 2020 USPQ2d 10729, at *7 (“Whether any given ‘generic.com’ term is generic, we hold, depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.”). “The Federal Circuit has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of goods or services at issue? Second, does the relevant public understand the term sought to be registered

primarily to refer to that genus of goods or services?” *GJ & AM*, 2021 USPQ2d 617, at *4-5 (citing *Marvin Ginn*, 228 USPQ at 530); *see also Booking.com*, 2020 USPQ2d 10729, at *5 (“[T]he relevant meaning of a term is its meaning to consumers”); *Uman Diagnostics*, 2023 USPQ2d 191, at *4.

i) The Genus

Because the recitation of services in a registration for a service mark defines the scope of rights accorded its owner, typically, “a proper genericness inquiry focuses on the description of services set forth in the certificate of registration.” *Magic Wand*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 111 USPQ2d 1495, 1496 (Fed. Cir. 2014) (“The Board found that the relevant goods were adequately defined by Nordic's description: ‘nutritional supplements containing DHA.’”); *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007). In this case and based on the record, we find that the relevant genus of services is commensurate with the recitation of services in the Respondent’s Registration, “legal services.” This identification is broad enough to include legal services of all types and practice areas.

ii) The Relevant Public

Next we determine the relevant public. In the context of a genericness inquiry, the relevant public is “the actual or potential purchasers of the services.” *Loglan Inst. Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand*, 19 USPQ2d at 1553).

Here, because there are no restrictions on or limitations to the channels of trade or classes of consumers in Respondent's Registration, the relevant public comprises ordinary consumers who use legal services, which may range broadly from individuals to small and large businesses, and other types of public and private entities. *See In re Mecca Grade Growers*, 125 USPQ2d at 1957 (Board took into account that the identification contained no restrictions as to trade channels or end users in determining the relevant public).

iii) Public Perception

We now turn to the critical issue in genericness cases, public perception. *See Marvin Ginn*, 228 USPQ at 530. "Evidence informing [the] ... inquiry [whether a term is generic] can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning." *Booking.com*, 2020 USPQ2d 10729, at *7 n.6; *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (citing *Princeton Vanguard, v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985) ("Evidence of the public's understanding of the mark may be obtained from 'any competent source, such as consumer surveys, dictionaries, newspapers and other publications.'")); *Cont'l Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999) (use of term "e-ticket" by media and competitors indicates term is generic for electronic tickets). "Genericness is a fact-intensive

determination and the Board's conclusion must be governed by the record which is presented to it.” *In re Country Music Ass’n, Inc.*, 100 USPQ2d at 1832.

As discussed above, the only evidence of record are Petitioner’s Notice of Reliance and various Internet printouts, albeit with no accompanying testimony. While the test for genericness is different from the test for descriptiveness, on this sparse record and given the limitations on the probative value of that evidence discussed at length above, we are unable to conclude that the evidence shows that Respondent’s Registration is generic.

In view of the limited evidence, Petitioner has not shown by a preponderance of the evidence that THE EDUCATION LAWYERS is generic for “legal services” or any subcategory thereof.

IV. Conclusion

After considering all the evidence of record, we find that Petitioner has not established the elements it must prove to prevail on its pleaded grounds for cancellation. Given the paucity of evidence, Petitioner falls short of demonstrating by a preponderance of the evidence that Respondent’s registered mark is generic or so highly descriptive that the declaration of five years continuous and substantially exclusive use under Section 2(f) is insufficient to establish acquired distinctiveness.

Decision: The petition to cancel is denied.